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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,594	03/15/2004	Joseph Edward Howard	75629/002	1793
75474 7590 12/10/2007 KANG INTELLECTUAL PROPERTY LAW, LLC 214 ELM STREET, SUITE 106 WASHINGTON, MO 63090			EXAMINER PAINTER, BRANON C	
			ART UNIT 3633	PAPER NUMBER
			MAIL DATE 12/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/800,594

Applicant(s)

HOWARD, JOSEPH EDWARD

Examiner

Branon C. Painter

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 14-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 4-7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman (U.S. Patent No. 4,727,698).

- a. Altman discloses a fireplace surround including:

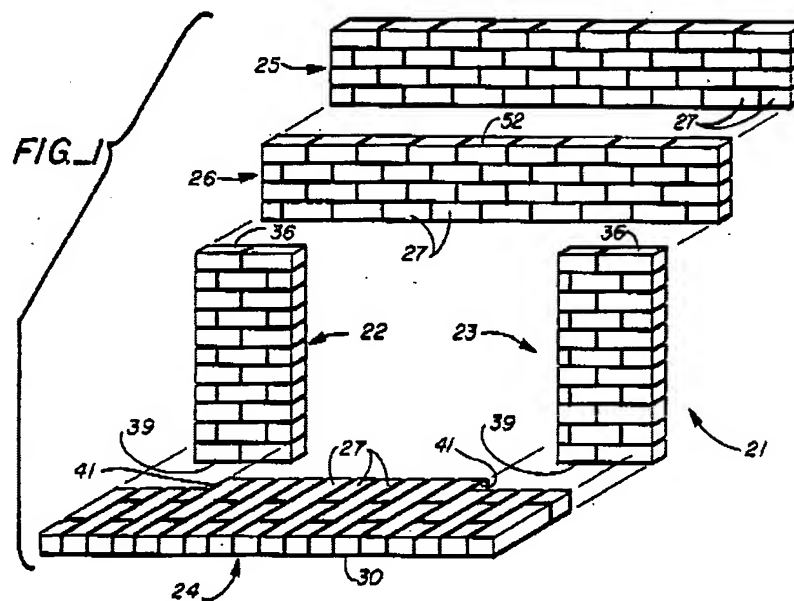
- i. A first and second leg adapted to be disposed vertically on opposing sides of a fireplace opening ("leg members" 22 and 23, Fig. 1).
- ii. A header adapted to be disposed horizontally over the fireplace opening ("lintel member" 26, Fig. 1).
- iii. Said first and second legs and said header comprising a single molded piece of material with a substantially flat back opposing the

face ("each of the sections is formed by molding the section from a brick-simulating material," column 4, lines 33-34).

- iv. Said header having a substantially flat base surface and said first and second legs having substantially flat top surfaces such that when the header is placed upon the top surfaces of the legs without grout between said header and said legs, the assembly fits closely together and gives the appearance of a unitary structure ("leg members" 22 and 23 and "lintel member" 26, Fig. 1).
- b. Altman does not expressly disclose that the first and second legs and header have the appearance and feel of non-uniform, dry-stacked stones with irregular outer edges.
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention to mold the fireplace surround pieces in the shape of dry-stacked stones rather than in the shape of bricks to provide consumers with a plurality of options regarding their fireplace surround façade. It is well-known in the art that consumers relish variety in their home decorating options.
- d. The examiner further notes that molding the fireplace surround pieces in the shape of dry-stacked stones would obviously produce surround pieces that felt like dry-stacked stones. Molds are created from the objects they mimic (in this case, the mold for dry-stacked stones would be made from dry-stacked stones). This allows the texture, whether smooth or rough, to be

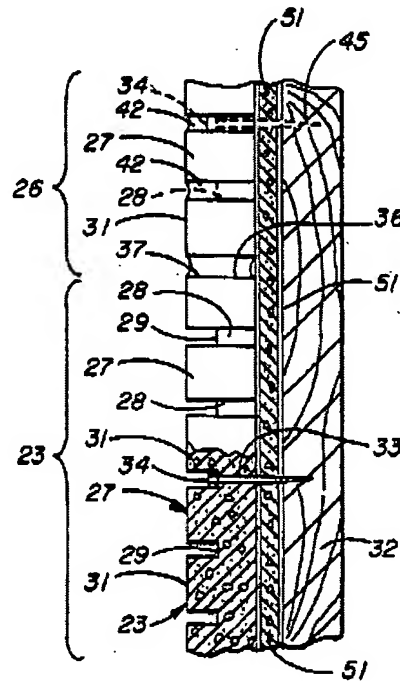
captured by the mold and transferred to the molded surround pieces, resulting in a texture-replicating surround piece.

- e. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.
- f. The examiner further notes that although Altman does suggest placing grout between the top surfaces of the legs and the bottom surface of the header, the claim as written only requires the legs and header to have a structure capable of fitting closely together when the header is placed atop the legs without an intermediate layer of grout. The legs and header of Altman clearly meet this limitation.



Reproduced from U.S. Patent No. 4,727,698

4. Regarding claim 4, Altman further discloses legs with an inner edge that is substantially flat ("leg members" 23, Fig. 1).
5. Regarding claim 5, Altman further discloses a plurality of anchors embedded in the first and second legs ("lag bolts" 33 in each leg, Fig. 3).



**FIG. 3**

Reproduced from U.S. Patent No. 4,727,698

6. Regarding claim 6, Altman further discloses a plurality of anchors embedded in the header ("lag bolts" 45, Fig. 3).
7. Regarding claim 7, Altman further discloses a header with a substantially flat surface ("intel member" 26, Fig. 1).
8. Regarding claim 9, Altman further discloses legs and a header made of a cementitious material ("In practice, the preferred brick-simulating material used in the

surround assembly of the present invention is a cement-based composition," column 4, lines 52-55).

9. Regarding claim 10, Altman further discloses legs and a header with surface shade color disposed therein ("Such brick simulating materials...can have a brick stain mixed therein," column 4, lines 57-60).
10. Claims 2, 3, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altman (U.S. Patent No. 4,727,698) as applied to claims 1, 4-7, and 9-10 above, and further in view of Petersen (U.S. Patent No. 4,913,131).
11. Regarding claim 2:
  - a. Altman discloses a fireplace surround as set forth above [claim 1].
  - b. Altman does not expressly disclose leg heights of over 36 inches.
  - c. Petersen discloses a fireplace surround with leg heights over 36 inches ("The height of member 43 from its bottom edge to its top edge, again for comparative purposes, is approximately 40 inches," column 7, lines 2-5).  
Giving the legs a height greater than 36 inches as taught by Petersen provides extra height so that the legs can be trimmed to fit a variety of standard fireplaces.
  - d. Altman and Petersen are analogous art because both are from the field of endeavor of fireplace surrounds.
  - e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the legs of Altman by making their height

greater than 36 inches as taught by Petersen in order to provide legs that are tall enough to fit a variety of fireplaces.

- f. The examiner notes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to produce legs with a height great enough to accommodate a large majority of fireplaces, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP 2144.05*.

12. Regarding claim 3, Altman further discloses legs made of a sawable or grindable material to adjust the leg lengths ("Height differences can be easily accommodated by cutting legs 22 and 23 with a circular saw fitted with a carborundum blade," column 5, lines 35-37).

13. Regarding claims 11-13:

- a. Altman in view of Petersen discloses a fireplace surround as set forth above, further including leg heights of about 37 inches ("The height of member 43 from its bottom edge to its top edge, again for comparative purposes, is approximately 40 inches," column 7, lines 2-5) [claim 12].
- b. Altman in view of Peterson discloses the claimed invention except for header lengths of more than 60 inches [claim 11] and header lengths of approximately 67 inches [claim 13]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to produce headers with a length great enough to accommodate a large majority of



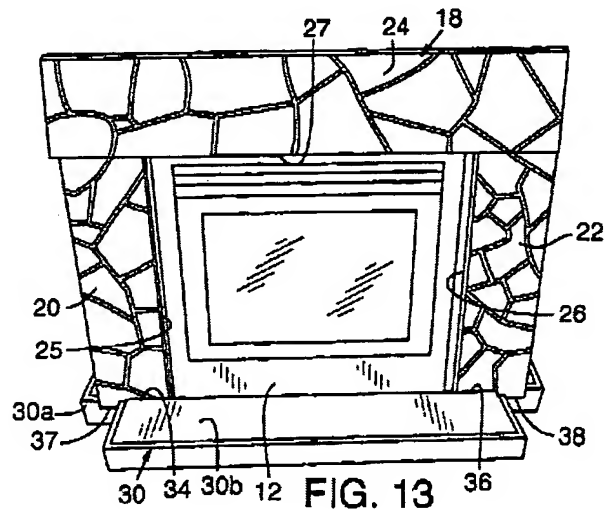
fireplaces, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP 2144.05*.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Altman (U.S. Patent No. 4,727,698) in view of Richmond et al. (U.S. Patent No. 6,796,088).

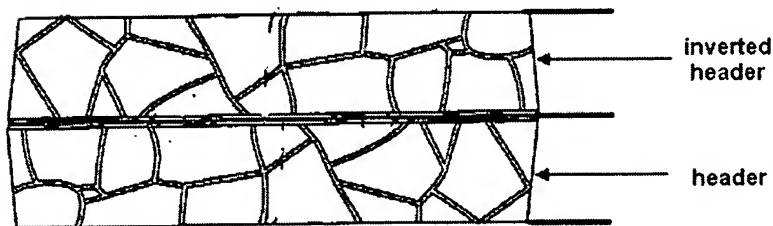
- a. Altman discloses a fireplace surround as set forth above [claim 1], further including a second header ("intel member" 25, Fig. 1).
- b. Altman does not expressly disclose a second header with a façade that is identical to the first header when oriented in the same direction, yet appears different when inverted.
- c. Richmond et al. discloses a header with a façade that appears different when inverted ("breast portion" 24, Fig. 13; examiner amended Fig. 13 shows the difference when two breast portions are stacked in the same and inverted orientations). Using a non-invertible pattern as taught by Richmond et al. allows two identical header pieces to be used together while appearing to be different pieces, which results in lower manufacturing costs.
- d. Altman and Richmond et al. are analogous art because both are from the field of endeavor of fireplace surrounds.
- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to produce the header pieces of Altman with a non-invertible pattern as taught by Richmond et al., in order to cut manufacturing costs and promote the appearance of non-uniform, dry-stacked stones.

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- f. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.



Reproduced from U.S. Patent No. 6,796,088



Reproduced from U.S. Patent No. 6,796,088 (Examiner amended)

***Response to Arguments***

15. Applicant's arguments filed 11/09/07 have been fully considered but they are not persuasive.
16. Applicant amended claim 1 to include the limitation that the fireplace surround pieces both look and feel like dry-stacked stones. Applicant states that this should overcome the examiner's rejection concerning the fact that aesthetic changes cannot be relied upon for patentability. The examiner notes, as added to the rejection above, that molding the fireplace surround pieces in the shape of dry-stacked stones would obviously produce surround pieces that felt like dry-stacked stones. Molds are created from the objects they mimic (in this case, the mold for dry-stacked stones would be made from dry-stacked stones). This allows the texture, whether smooth or rough, to be captured by the mold and transferred to the molded surround pieces, resulting in a texture-replicating surround piece.
17. Applicant argues that his invention is "in all respects a unitary structure of individual dry-stacked stones," and claims that Altman does not achieve a fireplace surround of "unitary structure" because the ultimate effect of Altman is one of a collection of individual bricks. The examiner notes that the ultimate effect of applicant's invention is one of a collection of individual stones. The examiner assumes that by "unitary structure," the applicant is attempting to state that when the legs and header are combined, the seams between the parts are unseen, resulting in a

combination of three surround pieces that seems to be a single, solitary surround piece. The examiner notes that Altman also achieves this illusion (see Fig. 2) .

18. Applicant further argues that Altman is only made to have the appearance of a brick fireplace surround. The examiner notes that the rejection was not a inherency rejection under 35 U.S.C. 102, but an obviousness rejection under 35 U.S.C. 103. The examiner stated in the first office action that "it would have been obvious to one of ordinary skill in the art at the time of the invention to mold the fireplace surround pieces in the shape of dry-stacked stones rather than in the shape of bricks to provide consumers with a plurality of options regarding their fireplace surround façade. It is well-known in the art that consumers relish variety in their home decorating options," and that the patentability of an invention cannot be achieved through aesthetic changes alone.
19. Regarding applicant's argument that the legs of Altman do not have "an outer edge with an irregular shape," the examiner again points to the first office action, where it is stated that "Altman does not expressly disclose...irregular outer edges." This feature would inherently be present in the dry-stacked stone molded surround pieces of the rejection, as it is well-known that dry-stacked stones do not have well-defined edges, and the stones used to create the mold would be dry-stacked stones.
20. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

21. Lastly, applicant argues that since none of the other references listed address the stated issues with claim 1, they are allowable. The examiner has shown that claim 1 does not contain allowable subject matter. Therefore, applicant's arguments regarding the secondary references used are also overcome.

### ***Conclusion***

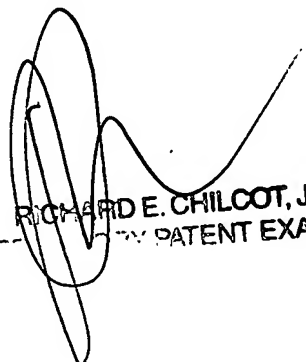
22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Branon C. Painter whose telephone number is (571) 270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Branon Painter  
11/28/2007

  
RICHARD E. CHILCOT, JR.  
SUPERVISOR PATENT EXAMINER